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OFFICE OF PETITIONS

In re Application of
David Chao Hua Wu
Application No. 10/629,797
Filed: July 30, 2003
Attorney Docket No. 1875.47300000

ON PETITION

This is a decision on the petition, filed August 31, 2007, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application. In the alternative petitioner has also requested consideration under 37 CFR 1.137(a).

The petition under is 37 CFR 1.181 **Dismissed**.

The petition revive under 37 CFR 1.137(a) is **Dismissed**.

Any request for reconsideration for the petition under 37 CFR 1.181 should be filed within **TWO MONTHS** of the mailing date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

This above-identified application became abandoned for failure to timely file a response to a final Office Action which was mailed via "e-Office action" on January 25, 2007. The final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on April 26, 2007. A Notice of Abandonment was mailed on November 28, 2007.

Petitioner states that the law firm opted out of the "E-Office Action Pilot Program" on January 25, 2007. Petitioner contends a review of docket records shows they did not

view the Office action. Petitioner further states that a search of the application file jacket and docket records shows that no new outgoing correspondence from the USPTO was entered or processed. Petitioner has also provided a statement from Carolyn Moore, the head of docketing.

A review of the file record shows that an e-mail notification was sent to petitioner on January 31, 2007. Further review shows that the e-mail notification of the mailing of the final Office action was reviewed by petitioner on February 2, 2007.

In a petition under 37 CFR 1.181 the petitioner must show, that petitioner is without fault in not receiving the communication. In the absence of any irregularity in the transmission , there is a strong presumption that the Office action was properly sent to the address of record. This presumption may be overcome by a showing that the Office action was not in fact received at the address of record.

Petitioner's argument has been considered but it is not convincing to establish the holding of abandonment should be withdrawn. Petitioner's evidence to establish that the final Office action was not received cannot overcome the Official record which shows that the e-mail notification was viewed by a representative of petitioner.

Petition Under 37 CFR 1.137(a)

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) the required reply,¹
- (2) the petition fee,
- (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

The Office is in receipt of petitioner's Request for Continued Examination (RCE).

The instant petition lacks item (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 37 C.F.R. § 1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Director to have been "unavoidable." See, 37 C.F.R. § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).² Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.³

Petitioner contends that Carolyn Moore, the head of docketing, informed counsel that an internal audit revealed that the above-identified application was abandoned. Ms. Moore has the responsibility for monitoring, reviewing and docketing all incoming correspondence including e-Office action correspondence. Ms. Moore and others in the docketing department participated in the USPTO webinar training on the pilot program. Additional training was also provided. Ms Moore had direct responsibility for receiving

²See MPEP 711(c) (III) (c) (2) for a discussion of the requirements for a showing of unavoidable delay.

³Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

and reviewing the e-mail notifications for customer 26111. The procedure for the pilot program included a person trained on using pair would go to private pair and view correspondence page. Once the outgoing correspondence was reviewed, documents were printed. Each printed USPTO document was logged into an incoming correspondence log. Further each USPTO document was to be logged into electronic docketing system (IPMASTER) and secondary backup paper docketing system.

However petitioner contends, for an unknown reason although the docketing department received e-mail notification, no Office action for the application was docketed. A review of the docketing system was conducted but the Office action was not found. Petitioner maintains that the abandonment was the result of clerical error.

While docket/clerical error can be construed as unavoidable, petitioner has failed to provide facts to warrant such a finding. A delay resulting from an error on the part of an employee in the performance of a clerical function may provide the basis provided it is shown 1) the error was the cause of the delay; 2) there was in place a business routine for performing the clerical function which could reasonably be relied upon to avoid errors in its performance and 3) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

However, clerical error in the form of careless mistakes or the result of a lack of knowledge of USPTO practices and procedures would not establish unavoidable delay.⁴ Petitioner has provided four additional instances in which, e-mail notifications did not result in obtaining an Office communication. The multiple missteps, suggests a lack of training and/or adequate supervision.

An adequate showing of unavoidable delay due to docket/clerical error may include but not limited to:

- 1) *statements by all parties with direct knowledge of the circumstances surrounding the delay;*
- 2) *a through explanation of the docketing system in use;*
- 3) *identification of the types of records kept;*
- 4) *identification of the persons responsible for the maintenance of the system, copies of mail ledger, docket sheets, file wrappers;*

⁴ See, e.g., *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891).

- 6) an indication why the system failed; and*
- 5) information regarding the training provided to the clerk(s) responsible for the docketing error, the degree of supervision of their work.*

Petitioner has failed provide information as to why the business routine explained in the petition was not followed. Petitioner has also failed to provide additional information regarding the degree of supervision provided to members of the docketing department, including that of Ms. Moore.

The facts presented suggest that instead of a clerical or docketing error that perhaps there is a systemic problem which would therefore preclude a finding of unavoidable delay.

ALTERNATIVE VENUE

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR 1.111 or (B) a continuing application under 37 CFR 1.53(b).
- (2) The petition fee as set forth in 37 CFR 1.17(m), **\$750.00 for a small entity;**
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional

A review of the record shows petitioner has not requested consideration under 37 CFR 1.137(b). Accordingly, the \$1500.00 will be refunded.

Further correspondence with respect to this matter should be addressed as follows:

By mail: **Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

By facsimile: **(571) 273-8300**

By delivery service: **U.S. Patent and Trademark Office
Customer Service Window,
Randolph Building
401 Dulany Street
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Telephone inquiries concerning this matter should be directed to the undersigned at
(571) 272-3215.

Charlema R. Grant

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